

REMARKS:

Claims 1-31 are currently pending in the application.

Claims 32-50 have been previously canceled without *prejudice*.

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,957,199 B1 to Fisher ("*Fisher*") in view of U.S. Publication No. 2002/0178127 to Byde (*Byde*).

Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of *Byde*, and in further view of U.S. Publication No. 2002/0040352 to McCormick ("*McCormick*").

The Applicants respectfully submit that all of the Applicants arguments are without *prejudice* or *disclaimer*. In addition, the Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicants further respectfully submit that by not responding to additional statements made by the Examiner, the Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicants are considered sufficient to overcome the Examiner's rejections.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The Applicants respectfully disagree and respectfully traverse the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph.

In the Response to Arguments section of the Final Office Action dated 31 December 2007, and with regard to Claims 1-31, the Examiner asserts that:

- A) “Though the examiner does agree with the applicant that the term ‘meta-model’ does occur in the specification, the examiner asserts that the term is not defined in a way to allow one of ordinary skill in the art to use the invention;”
- B) “The examiner asserted a definition to the phrase ‘meta-model’ to be a ‘trading partner agreement’ for examination purposes;”
- C) “The applicant appeared to define a meta-model to be a trading partner agreement;”
- D) “A trading partner agreement element can be negotiated by two or more enterprises and incorporated into a negotiated trading partner agreement;”
- E) “The applicant fails to disclose which portions of the ‘meta-model’ as set forth by the specification negate the assertion of a trading partner agreement;” and
- F) “The applicant fails to specifically mention one limitation of ‘meta-model’ that causes a trading partner agreement to not be a ‘meta-model.’”

(31 December 2007 Final Office Action, Page 3-4). For the reasons set forth at length below, the Applicant respectfully disagrees and respectfully traverses the Examiner’s rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph.

The Term ‘Meta-Model’ is Clearly Defined in the Applicants Specification

With respect to the Examiner’s assertion “A” above, the Applicants respectfully submit that the term “meta-model” is clearly, concisely and exactly defined in numerous

places in the Applicants specification. In addition, the term “**meta-model**” is defined with such specificity as to clearly render definite the Applicants claims.

In particular, page 7 of the Applicants specification contains at least the following clear, concise definition of the term “**meta-model**”:

A meta-model is a description of a TPA that software, such as collaboration software 16, can read and understand. A meta-model may contain XML data or any other suitable type of software-readable data, depending on the implementation.

(See Specification, Page 7, Lines 13-15). (Emphasis Added). As can be seen from the foregoing passage, the term “**meta-model**” is clearly defined in the Applicants specification. In particular, the Applicants specification is clear that a “**meta-model**” is a “**description of a TPA**” (as opposed to **being** a TPA). Furthermore, not only is the term “**meta-model**” clearly defined in the specification, its relationship to software (such as collaboration software 16) is likewise clearly described. Specifically, a “**meta-model**” may “contain XML data or any other suitable type of software-readable data” and, in any event, is a “description of a TPA that software, such as collaboration software 16, can read and understand.” Accordingly, as is set forth in more detail herein, the term “**meta-model**” is defined with such specificity as to render definite the Applicants claims within the meaning of 35 U.S.C. § 112, second paragraph.

In addition to the preceding cited passage, the term “**meta-model**” is further defined in the Applicants specification. In particular, Page 9 of the Applicants specification describes the **formulation** of a “**meta-model**”:

Through MMNS 18, enterprises 12 and 12f negotiate ***one or more meta-model elements that will be used to formulate a meta-model describing a negotiated TPA*** customized for their needs and suitable for their future

collaboration.

(Specification, Page 9, Lines 19-22). (Emphasis Added). Therefore, a “**meta-model**” itself is formulated via “one or more **meta-model** elements,” which are defined at length in the Applicants specification. Specifically, page 10, lines 4-6 of the Applicants specification sets forth a definition of a “**meta-model** element” thusly:

each meta-model element typically deals with an associated set of potential terms, definitions, or standards that may collectively provide a complete description of a negotiated TPA.

(Specification, Page 10, Lines 4-6). (Emphasis Added). Accordingly, in light of the foregoing cited passages it is clear that the Applicants have clearly, concisely and fully defined the term “**meta-model**” in numerous places in the Applicants specification. More particularly, the term “**meta-model**” is defined with such specificity as to clearly render definite the Applicants claims.

Once again, the Applicants have clearly defined what a “**meta-model**” *is* (“a description of a TPA”), its **relationship** with software (software can read and understand); the Applicants have further clearly described the particular manner in which a “**meta-model**” is **formulated** (**meta-model** elements), as well as defining “**meta-model** elements” themselves.

Therefore, as evidenced by the preceding passages, the Applicants fully described and defined the term “**meta-model**” sufficiently as to clearly render definite the Applicants claims.

In light of the Applicants clear, concise and full definition of the term “**meta-model**,” the Examiner’s assertion of the Examiner’s own definition of a “**meta-model**” is simply valid. Moreover, the Applicants respectfully submit that the definition of “**meta-model**” asserted by the Examiner clearly contradicts the clear definition of the term set forth at length in the Applicants specification.

It is well-established that claims must be given their “broadest reasonable interpretation” in light of the specification. (see MPEP §2111). Specifically, an examiner must interpret “verbiage of the proposed claims [in] the broadest reasonable meaning in their ordinary usage as they would be understood by one of ordinary skill in the art, ***taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.***” (MPEP 2111, citing *In re Morris*, 127 F. 3d. 1048, 1054-55, 44 USPQ2d 1023, 1027-27 (Fed. Cir. 1997)). As noted above, the term “***meta-model***” is clearly defined and described in numerous places Applicants specification. Thus, the Applicants respectfully submit that the Examiner’s construction of the term “***meta-model***” in a manner inconsistent with Appellants’ specification is in plain error.

The Examiner has Improperly Asserted a Definition of the term ‘Meta-Model’

Referring to the Examiner’s assertions “B” and “C” above, the Examiner has asserted a definition of the term “***meta-model***” “***to be a ‘trading partner agreement’ for examination purposes.***” (31 December 2007 Final Office Action, Page 3). As putative substantiation for this definition, the Examiner has asserted that “the applicant appeared to define a ***meta-model*** to be a trading partner agreement” which, in light of the Applicants specification, is clearly not the case. (31 December 2007 Final Office Action, Page 3).

As an initial matter, the Applicants respectfully submit that it is improper for the Examiner to assert a definition of the term “***meta-model***” when that term, as noted above, is clearly, concisely and fully defined in the Applicants specification. The Applicants respectfully request clarification as to why the Examiner would proffer a definition of a term *sua sponte* when exhaustive definitions for that term were already set forth at length in the Applicants specification (as clearly shown above).

In addition to the fact that the Examiner has improperly asserted a definition of the term “***meta-model***” when a clear definition was already provided by the Applicants, the Examiner’s asserted definition of the term “***meta-model***” does not comport with, and even

directly contradicts, the thorough and careful definition provided by the Applicants in their specification.

As noted above, and notwithstanding the Examiner's assertion, the Applicants specification makes clear that a "**meta-model is a description of a TPA.**" Nevertheless, the Examiner asserts a "definition to the phrase '**meta-model**' to **be** a 'trading partner agreement' for examination purposes." As can be seen from a comparison of the Applicants **actual** definition of the term "**meta-model**," as set forth in their specification, and the definition asserted by the Examiner, there is simply no equation between a "**description of a TPA**" and a "TPA" itself. In particular, the "**meta-model**" described and defined by the Applicants in their specification relates to a "**description of a TPA**" rather than a TPA itself. It is clear that there is simply no equivalence between a "description" of a something and the thing itself. Using a different example, one cannot properly argue that a "description" of a contract is equivalent to a "contract" itself. After all, while a contract itself is capable of being legally executed and enforced, a mere description of the contract is not. Similarly, there is simply no equation between the definition of **meta-model** set forth by the Applicants as a "description of a TPA," and the definition of "**meta-model**" by the Examiner as a "TPA" itself. In particular, in contrast to the Examiner's asserted definition of a "**meta-model**" as **being** a "TPA," or the thing itself, the Applicants definition of "**meta-model**" relates to a "**description of a TPA**" or a "**description**" of a TPA. Therefore, the Applicants respectfully submit that the Examiner's asserted definition of the term "**meta-model**" is clearly improper and simply does not make sense in light of the clear descriptions contained in the Applicants specification.

Thus, the Applicants respectfully submit that the Examiner has improperly crafted a definition of the term "**meta-model**" despite there existing clear support for the term in the Applicants' specification. As shown by comparison above, the Applicants respectfully submit that the Examiner's construction of the term "**meta-model**" fails to account for significant aspects of Applicants' "**meta-model**" as set forth in the specification. Accordingly, the Applicants respectfully submit that the Examiner's asserted definition of "**meta-model**" is improper in light of the clear definition provided for the term in Applicants specification.

The Definition of ‘*Meta-Model*,’ as Set Forth in the Applicants Specification, Negates the Examiner’s Assertion of ‘*Meta-Model*’ as a Trading Partner Agreement

With respect to the Examiner’s assertions “E” and “F” above, the Applicants respectfully point out that the clear, concise and full definition of the term “***meta-model***” provided by the Applicants clearly negates “the assertion of a trading partner agreement.” (31 December 2007 Final Office Action, Page 3). In addition, the Applicants respectfully submit that there does exist at least “one limitation of ‘***meta-model***’ that causes a trading partner agreement to not be a ‘***meta-model***.’” (31 December 2007 Final Office Action, Page 3-4). Each of the Examiner’s assertions will be addressed, in turn, below.

First, the Examiner asserts that “the applicant fails to disclose which portions of the ‘***meta-model***’ as set forth by the specification negate the assertion of a trading partner agreement.” The Applicants respectfully submit that the portion of the definition of a “***meta-model***” as a “***description*** of a TPA” (as opposed to actually ***being*** a TPA) alone is sufficient to negate the Examiner’s assertion of a “***meta-model***” as a “trading partner agreement.” (See Specification, Page 7, Lines 13-15).

In particular, the existence of a “***meta-model***” as a “description” of a TPA plainly negates the assertion that a “***meta-model***” ***is*** a “trading partner agreement.” Once again, a description of something is not equivalent to the thing itself. This clear fact alone negates the Examiner’s assertion that a “***meta-model***” ***is*** a “trading partner agreement.”

In addition to the foregoing, the Examiner asserts that “the applicant fails to specifically mention one limitation of ‘***meta-model***’ that causes a trading partner agreement to not be a ‘***meta-model***.’” (31 December 2007 Final Office Action, Page 3-4). The Applicants respectfully submit that, as set forth in the Applicants specification, a “trading partner agreement” (“TPA”) relates to the “negotiated standard” between “two or more enterprises.” (Specification, Page 7, Lines 7-9). Accordingly, while a “trading partner agreement” relates to the actual “negotiated standard,” a “***meta-model***” relates at least to a “***description*** of a TPA” or a ***description*** of a “negotiated standard.”

Thus, the fact that a trading partner agreement” pertains to the actual “negotiated standard” whereas a “***meta-model***” relates at least to a “***description***” of a “negotiated

standard,” demonstrates “one limitation of ‘**meta-model**’ that causes a trading partner agreement to not be a ‘**meta-model**.’” (31 December 2007 Final Office Action, Page 3-4). (Emphasis Added).

Each Instance of the Term ‘Meta-Model’ in the Applicants Claims is Clearly Defined

In the Examiner’s Response to Arguments section, beginning on Page 2 of the 31 December 2007 Final Office Action, the Examiner asserts that “the repetitious use of the term **meta-model** to define different aspects of **meta-models** is vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be.”

Notwithstanding the Examiner’s assertion, the Applicants respectfully submit that the relationship between each and every instance of the term “**meta-model**” in Applicants claims are clearly defined, at least in the specification, as well as, being clear in Applicants claims themselves. Applicants respectfully submit that, beyond making a generalized conclusion, the Examiner does not set forth *any* reasoning to indicate why it is believed that the clearly defined use of the term **meta-model** point is considered “vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be.”

Once again, as noted above, the Applicants have clearly defined what a “**meta-model**” *is*, that is, a “**description** of a TPA.” The Applicants have likewise defined the **relationship** of a “**meta-model**” to software (software can read and understand the **meta-model** description). In addition, the Applicants have further clearly described the particular manner in which a “**meta-model**” is **formulated**, in particular *via meta-model* elements. Moreover, the Applicants have defined “**meta-model** elements” themselves as “each **meta-model element** typically deals with an associated set of potential terms, definitions, or standards that may collectively provide a complete **description** of a negotiated TPA.” Accordingly, in light of the clear manner in which “**meta-models**” have been defined by the Applicants in their specification, and in further light of the fact that “**meta-models**” relationships to other components have been described, the reason for the Examiner’s misunderstanding is unclear. In addition, the term “**meta-model**” is used in Applicants

independent Claim 1 in only the following ways: “**Meta-Model** elements” (Claim 1, Line 3); “Negotiated **meta-model**” (Claim 1, Line 5); and “**Meta-model** negotiation service” (Claim 1, Line 9). The relationships between the different usages of the term “**meta-model**” are clearly set out at least in the Applicants specification, as well as in the Applicants claims.

The term “**meta-model** element,” as noted above, is defined at least in Applicant’s specification at Page 10, Lines 4-6. Accordingly, since the term “**meta-model** element” is clearly defined in the Applicants specification, and since the language of the Applicants Claim 1 at least parallels the term “**Meta-model** element” as defined in the Applicants specification, the Examiner’s lack of clarity with regard to the use of this term is inexplicable. Accordingly, Applicants respectfully submit that the meaning of the term “**meta-model** element” is clear in light of the Applicants specification and claims.

Likewise, the meaning of the term “negotiated **meta-model**” is clearly defined in the Applicants specification, at least in Applicants Specification at Page 11, Lines 9-10. In addition, a “negotiated **meta-model**” is illustrated at least in Figure 4 of the Applicants specification. Thus, since the term “negotiated **meta-model**” is clearly defined by the Applicants in the specification, and since a “negotiated **meta-model**” in relation to other elements is disclosed at least in Figure 4 of the Applicants specification, the Examiner’s lack of understanding with regard to the use of this term is baffling. Ultimately, the Applicants respectfully submit that the meaning of the term “negotiated **meta-model**” is clear in light of Applicants’ specification and claims.

In addition to the foregoing, the meaning of the term “**meta-model** negotiation service” is clearly defined. Specifically, the term “**meta-model** negotiation service” is defined at least in the Applicants specification at Page 7, Lines 18-27. Since the term “**meta-model** negotiation service” is clearly defined by the Applicants in the specification, and since the language of the Applicants Claim 1 uses at least the term “**meta-model** negotiation service” as defined at least in the Applicants specification, the Applicants respectfully submit that the meaning of the term “**meta-model** negotiation service” is abundantly clear in light of the Applicants specification and claims.

Thus, for the reasons set forth above, the Applicants respectfully submit that the rejection of Claims 1-31 under 35 U.S.C. §112, second paragraph, is improper and must be withdrawn.

REJECTION UNDER 35 U.S.C. § 103(a)

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 103(a) under *Fisher* in view of *Byde*. Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of *Byde*, and in further view of *McCormick*. For the reasons set forth at length below, the Applicants respectfully disagree and respectfully traverses the Examiner's rejection of Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 under 35 U.S.C. § 103(a).

The Examiner Acknowledges that *Fisher* Does not Use the Exact Phrasing of Negotiation in Reference to Trade Agreements'

The Applicants respectfully submit that *Fisher* does not teach, suggest, or even hint at a "***negotiated meta-model***." In fact, even ***the Examiner acknowledges that Fisher does not teach "negotiation in reference to trade agreements."*** (31 December 2007 Final Office Action, Page 9-10). (Emphasis Added).

The Applicants respectfully submit that it is logically inconsistent, and therefore improper, for the Examiner to acknowledge on the one hand that *Fisher* does not teach "negotiation in reference to trade agreements," but assert on the other hand that *Fisher* teaches "communicating the ***negotiated meta-model*** to the enterprises". (31 December 2007 Final Office Action, Page 9-10). The Applicants respectfully submit that it simply does not make sense that *Fisher* could be silent as to "negotiation in reference to trade agreements" on the one hand (which the Examiner acknowledges), but somehow teaches "communicating the ***negotiated meta-model***" on the other hand.

Therefore, the Applicants respectfully submit that since *Fisher* in no way teaches "negotiation in reference to trade agreements," *Fisher* simply cannot teach "communicating the ***negotiated meta-model***." Ultimately, since *Fisher* does not teach

negotiation in reference to trade agreements (by the Examiner's own acknowledgement), and since the Examiner has (improperly) interpreted the term "**meta-model**" to mean a "trade partner agreement" then, according to the Examiner's own logic, *Fisher* simply cannot teach a "*negotiated*" meta model since *Fisher* does not teach "negotiation in reference to trade agreements." Thus, for at least the reasons shown above, *Fisher* simply *does not* teach "*negotiated* meta models."

The Proposed *Fisher-Byde* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants' Claims

The Applicants respectfully submit that the proposed *Fisher-Byde* combination fails to disclose key elements of the Applicants claims.

In particular, *Fisher* and *Byde*, in their entirety, fail to disclose a "**negotiated meta-model**", as recited in independent Claim 1. Specifically, while the Examiner asserts that "*Fisher* teaches negotiations, trade agreements, and the rules within trading," it is clear that nowhere does *Fisher* disclose, teach or suggest a "**meta-model**" as claimed by the Applicants and as described in the Applicants specification. Moreover, as shown above, **there is simply no equivalence between the "meta-model" of the subject application and the "trading partner agreement" of *Fisher*.** In addition, *Byde* is utterly silent as to a "meta-model," as defined in the Applicants specification, by whatever name one chooses to call it. Specifically, and with respect to Independent Claim 1 of the subject application, the portions of *Fisher* and *Byde* relied upon by the Examiner (and, in fact, the entirety of *Fisher* and *Byde*) fail to disclose, teach or suggest Independent Claim 1 elements at least relating to:

a negotiated **meta-model** that **describes** an agreement between the enterprises as to collaborations between the enterprises

Notwithstanding the clear fact that the Examiner acknowledges, and the Applicants agree, that *Fisher* fails to disclose "negotiation in reference to trade agreements," the Examiner nevertheless inexplicably asserts that "[i]t **would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Fisher* to include**

more details regarding negotiations.” (31 December 2007 Final Office Action, Page 10). (Emphasis Added). The Applicants respectfully disagree.

In light of the Examiner’s clear acknowledgement that that *Fisher* fails to disclose “negotiation in reference to trade agreements,” ***The Applicants respectfully submit that it would not have been, clearly would not have been, obvious “to include more details regarding negotiations” in Fisher when, by the Examiner’s own admission, Fisher does not teach “negotiations in reference to trade agreements,” at all.*** Therefore, it is logically inconsistent to assert that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Fisher* to include more details regarding negotiations” when, once again, *Fisher* is completely silent as to “negotiation in reference to trade agreements. For at least these reasons, Applicants respectfully submit that the basis underlying the Examiner’s assertion cannot be logically supported.

Applicants further respectfully submit that the Examiner has apparently taken official notice of what constitutes the level of ordinary skill in the art, and has further improperly relied upon the officially-asserted level of skill in the art in order to provide motivation. Applicants respectfully traverse this taking of Official Notice.

The Examiner has Improperly Taken Official Notice

In addition to the foregoing, the Examiner also asserts that “[t]hough *Fisher* may not state negotiations around the term trade agreement it is viewed that trade agreements require by nature negotiations.” The Applicants respectfully disagree and respectfully traverse the Examiner’s taking of Official Notice.

Furthermore, under these circumstances, ***it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner’s conclusion.*** (See MPEP § 2144.03). The Applicants respectfully request the Examiner to produce authority for the Examiner’s purported Official Notice.

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘*capable of such instant and unquestionable demonstration as to defy the dispute*’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)).

“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis added). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). Accordingly, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submits that ***the Office Action provides no documentary evidence to support the purported Official Notice taken by the Examiner***, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicants further submit that the Applicants have adequately traversed the Examiner’s assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, should the Examiner continue to maintain the rejections of Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 based upon the Examiner’s Official Notice, Applicants respectfully request that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge, the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further required by MPEP § 2144.03(C).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Fisher/Byde* Combination According to the UPSTO Examination Guidelines

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Fisher* or *Byde*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining

Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject Application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the**

obviousness rejection based on the proposed combination of *Fisher* and *Byde*, either individually or in combination. The Office Action merely states that “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fisher to include the specific details of structure of transaction, data elements, state model describing the cycle, accessing that a role type has data elements, or actions that a role type can execute.” (31 December 2007 Final Office Action, Page 10).

The Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the ***factual findings necessary to establish obviousness*** and is not a sufficient ***explanation to support the obviousness rejection*** based on the proposed combination of *Fisher* and *Byde*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.***

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether the Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain whatsoever why the difference(s) between the proposed combination of Fisher and Byde,, either individually or in combination and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action is completely silent as to ***why*** "it would have been obvious" to modify *Fisher*. (31 December 2007 Final Office Action, Page 10) The Applicant respectfully disagrees and further respectfully requests clarification as to ***why the difference(s) between the proposed combination of Fisher and Byde, either individually or in combination, and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "***the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.***" (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "[R]ejections on ***obviousness cannot be sustained by mere conclusory statements***; instead, there ***must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***" (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Applicant respectfully submits that the **Office Action fails to provide any articulation, let alone, clear articulation of the reasons why the Applicant’s claimed invention would have been obvious**. For example, the **Examiner has not adequately supported the selection and combination of Fisher and Byde, to render obvious the Applicant’s claimed invention**. The Examiner’s unsupported conclusory statements that ““it would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to modify *Fisher* to include the specific details of structure of transaction, data elements, state model describing the cycle, accessing that a role type has data elements, or actions that a role type can execute” **does not adequately provide clear articulation of the reasons why the Applicant’s claimed invention would have been obvious**. (31 December 2007 Final Office Action, Page 10). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines’ rationales to render obvious the Applicant’s claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Fisher* and *Byde*, **the Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an explicit analysis of the rationale relied upon by the Examiner**.

The Applicants Claims are Patentable over the Proposed *Fisher-Byde-McCormick* Combination

The Applicants respectfully submit that, as discussed above, independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher*, *Byde*, or *McCormick*.

Furthermore, with respect to dependent Claims 2-10, 12-20, and 22-30: Claims 2-10 depend from independent Claim 1; Claims 12-20 depend from independent Claim 11; and Claims 22-30 depend from independent Claim 21. As mentioned above, each of independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher*, *Byde*, or *McCormick*. Thus, dependent Claims 4, 5, 14, 15, 24, and 25 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 1-31 are not rendered obvious by the proposed combination of *Fisher*, *Byde*, or *McCormick*. The Applicants further respectfully submit that Claims 1-31 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-31 be allowed.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

28 February 2008
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

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